

## REMARKS

In the Office Action dated August 24, 2005, claims 1-21 stand rejected. Applicants thank the Examiner for withdrawing the informalities objection to claim 5 and the double patenting rejections of claims 1-21. Applicants respectfully submit that the Examiner's remaining rejections of the pending claims as set forth in the Office Action have been overcome and that claims 1-21 now pending in the present application are allowable over the cited art for the reasons set forth below.

### **C. Claim Rejections - 35 U.S.C. § 103**

#### **1. 35 U.S.C. § 103 – *Bialick* in view of *Estakhri***

Claim 1 of the present application recites:

1. A unitary portable biometrics-based access control device which can be directly plugged into a universal serial bus (USB) socket communicatively coupled to a restricted resource, the device comprising:
  - a housing;
  - a microprocessor housed within the housing;
  - a USB plug integrated into the housing without an intervening cable and capable of coupling the unitary portable access control device directly to the USB socket;*** and
  - a biometrics-based authentication module coupled to and controlled by the microprocessor, at least a portion of the biometrics-based authentication module being housed within the housing, wherein access to the restricted resource is granted to a user provided that the biometrics-based authentication module authenticates the user's identity and wherein access to the restricted resource is denied to the user otherwise.

(Emphasis provided).

In the present Office Action, the Examiner states that certain features upon which Applicants rely (i.e., a portable device that can be directly plugged into a USB socket communicatively coupled to a restricted resource and which has a USB plug integrated into its housing without an intervening cable and capable of coupling the device directly to the USB socket, or the use of such a device in an access control system) are not recited in the claims. Applicants respectfully disagree and submit that those features are already recited in

the claims. For example, in claim 1, “a USB plug integrated into the housing without an intervening cable and capable of coupling the unitary portable access control device directly to the USB socket” has been included as a limitation. In claim 11, “a portable device which can be directly plugged into a universal serial bus (USB) socket communicatively coupled to the restricted resource” and “a USB plug integrated into the housing without an intervening cable and capable of coupling the portable device directly to the USB socket” have been included as limitations. In claim 17, “directly plugging the portable device into a universal serial bus (USB) socket communicatively coupled to the restricted resource” and “a USB plug integrated into the housing without an intervening cable and capable of coupling the portable device directly to the USB socket” have been included as limitations. Accordingly, Applicants submit that the pending claims clearly include all the features upon which Applicants rely.

Claims 1-8 and 11-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,088,802 (hereinafter “*Bialick*”) in view of U.S. Patent No. 6,385,667 (hereinafter “*Estakhri*”). Applicants respectfully disagree with the Examiner’s reading of the disclosures in both *Bialick* and *Estakhri* and submit that *Bialick* and *Estakhri*, alone or in combination, fail to teach or disclose various claimed limitations of the pending claims.

Applicants respectfully note that the cited discussions in *Bialick* and *Estakhri* and relied on by the Examiner fail to teach or disclose, among other things, the claimed limitations “a USB plug integrated into the housing without an intervening cable and capable of coupling the unitary portable access control device directly to the USB socket” (claim 1), “a portable device which can be directly plugged into a universal serial bus (USB) socket communicatively coupled to the restricted resource” and “a USB plug integrated into the housing without an intervening cable and capable of coupling the portable device directly to the USB socket” (claim 11), and “directly plugging the portable device into a universal serial

bus (USB) socket communicatively coupled to the restricted resource” and “a USB plug integrated into the housing without an intervening cable and capable of coupling the portable device directly to the USB socket” (claim 17). This is explained in more detail below.

Applicants agree with the Examiner that *Bialick* does not disclose the integrated USB plug as claimed. However, the Examiner then cites *Estakhri* for the proposition that it remedies these deficiencies in *Bialick*. The Examiner further suggests that it is obvious to modify *Bialick* to come up with a device as claimed and that *Estakhri* provides the motivation to do so. Applicants respectfully disagree.

*Estakhri* teaches a very different device than that disclosed and claimed in the present application. *Estakhri* teaches a device that allows different memory cards to be used in conjunction with an interface device to facilitate access to information stored in the memory cards. As illustrated in Figure 3, *Estakhri* discloses an interfacing system 300 that can receive a memory card 320 with a 50-pin connection for coupling to a separate interface device 310. Interface device 310 is configurable to various operating modes, each utilizing a different communication protocol. Memory card 320 can likewise be configured to any of various operating modes to match that of interface device 310. When memory card 320 and host computer 335 are connected to interface device 310, host computer 335 can access information stored in memory card 320 via interface device 310. *See, e.g.*, col. 5, line 13 to col. 6, line 24.

The Examiner suggests that *Estakhri* teaches a USB plug integrated into the housing without an intervening cable and capable of coupling the unitary portable data storage device directly to a USB socket on a host computer. Applicants respectfully traverse. As discussed above, *Estakhri* teaches an interfacing system that supports multiple operating modes and communication protocols. However, *Estakhri* does not teach using a USB plug as an integral part of a portable device. Rather, *Estakhri* teaches using a 50-pin connection as a first

interface (element 315) for connection to a removable memory card and at the same time using a second interface (element 314), which can support any of a number of different communication protocols. This structure taught in *Estakhri* is inconsistent with having a USB plug. Clearly, *Estakhri* does not teach or disclose a USB plug that is integrated into a portable data storage device, which is a required limitation in the pending claims.

Applicants respectfully traverse the Examiner's position regarding suggestion or motivation to combine the teachings in *Bialick* and *Estakhri*. Specifically, Applicants respectfully submit that the statement in *Estakhri* that the invention therein relates to "interfacing systems facilitating user-friendly connectivity between host computer systems and flash memory cards" (col. 1, lines 16-17) does not provide the requisite suggestion or motivation to modify the teaching in *Bialick* with the teaching in *Estakhri* – even if the two references can be combined, which the Examiner suggests and Applicants respectfully traverse – to arrive at the claimed invention in the present application.

The Examiner states that *Bialick* and *Estakhri* are in analogous arts and that it would have been obvious to a skilled artisan at the time of the invention to combine the two references. Applicants respectfully traverse. The fact that *Bialick* and *Estakhri* refer to flash memory and the USB protocol does not, without more, make the two references combinable. Moreover, as discussed above, *Bialick* teaches an access control system that serves to restrict access to information stored in a host computer, whereas *Estakhri* teaches an interfacing system that facilitates access to information stored in multiple memory cards. Thus, Applicants maintain that *Bialick* and *Estakhri* teach two distinct endeavors that seek to achieve opposite results: restricting access to stored information in a host computer versus facilitating access to stored information in multiple memory cards. This is another reason that a skilled artisan would not seek to combine the teachings in *Bialick* and *Estakhri* to come

up with the claimed invention in the present application, and that the pending claims are patentable in view of *Bialick* and *Estakhri*.

Thus, for at least the foregoing reasons, claims 1, 11 and 17 and the claims dependent therefrom in the present application are not rendered obvious by *Bialick* in view of *Estakhri*.

With respect to claims 6, 16 and 21, the Examiner cites col. 10, lines 45-47 of *Bialick* and states that *Bialick* teaches using an acceptable access code such as a password or PIN before allowing access. The Examiner also states that it is obvious to modify *Bialick* to provide a bypass mechanism as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree and point out that *Bialick* teaches “the user must successfully enter an acceptable access code (e.g., a password or PIN) ...” before being allowed access and that it is desirable to “require an access code before enabling the user to use the security functionality ...” (col. 10, lines 46-50). Thus, *Bialick* teaches that the access code be used *in addition to* and *in conjunction with* biometrics-based authentication. In other words, the access code referred to in *Bialick* cannot be a *bypass mechanism*, which by definition is used to *bypass*, or *in lieu of*, the biometrics authentication. As such, Applicants respectfully maintain that claims 6, 16 and 21 are patentable over the cited reference for this additional reason.

With respect to claim 8, the Examiner cites col. 9, lines 9-11 of *Bialick* and states that *Bialick* that the peripheral device can be made accessible to the host computing device via an appropriate interface such as network connection. The Examiner also states that it is obvious to modify *Bialick* to provide access control to a communication network as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree. Even if the cited discussion in *Bialick* means that the device disclosed therein can be communicate with the host computing device over a network connection, it neither teaches or discloses using a portable device to provide access control to a communication network, nor

provides any motivation for the modification suggested by the Examiner. While they both interact with a network in operation, a device having the ability to connect to a network and a device that can provide access control to a communication network are two different devices and entail two distinct endeavors. A device that can connect to a network is not necessarily able to provide access control to a network. Indeed, most are not. As such, Applicants respectfully maintain that claim 8 is patentable over the cited reference.

With respect to claim 19, the Examiner cites col. 12, lines 12-13 of *Bialick* and states that *Bialick* teaches encrypting and decrypting data stored on the host-computing device. The Examiner also states that it is obvious to modify *Bialick* to encrypt and store the biometrics marker as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully traverse. As the Examiner has pointed out, in the cited discussion *Bialick* teaches encrypting and decrypting *data stored on the host-computing device*. However, the cited discussion in *Bialick* fails to teach or disclose encrypting and decrypting *data stored in the portable device* as required in the claims. While the use of encryption technique to protect confidential information is well known, performing encryption and decryption on data stored within a portable device and performing such operations on data stored in a host computer to which a portable device is connected are different endeavors. Accordingly, Applicants respectfully submit that the cited discussion in *Bialick* does not render the claimed subject matter obvious and maintain that claim 19 is patentable over the cited reference.

## **2. 35 U.S.C. § 103 – *Bialick* in view of *Burger***

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bialick* in view of U.S. Patent No. 6,219,439 (hereinafter “*Burger*”). Applicants respectfully disagree with the Examiner’s reading of the disclosures in both *Bialick* and *Burger* and submit that *Bialick* and *Burger*, alone or in combination, fail to teach or disclose various claimed limitations of claims 9 and 10.

For the same rationale as discussed above in section A.1, *Bialick* fails to teach or disclose a portable device having an integrated USB plug as claimed. *Burger* does not address these deficiencies in *Bialick*. Accordingly, claims 9 and 10 are patentable over *Bialick* and *Burger*, alone or in combination, at least for this reason.

The Examiner agrees that *Bialick* does not disclose a portable device that can provide access control to a real estate premises that imposes access restrictions or to an operable machinery the safe operation of which requires training, which are claimed in claims 9 and 10 respectively. However, the Examiner then cites *Burger* for the proposition that it remedies these deficiencies in *Bialick*. The Examiner further suggests that it is obvious to modify *Bialick* to come up with a device as claimed and that *Burger* provides the motivation to do so. Applicants respectfully disagree.

Applicants respectfully traverse the Examiner's position regarding suggestion or motivation to combine the teachings in *Bialick* and *Burger*. Specifically, Applicants respectfully submit that the statement in *Burger* that the invention therein seeks to "provide for an open, stand-alone system" (col. 3, lines 28-29) does not provide the requisite suggestion or motivation to modify the teaching in *Bialick* with the teaching in *Burger* to arrive at the claimed invention in the present application. A skilled artisan would not seek to combine the teachings in the cited art of record to come up with the claimed invention in the present application, and claims 9 and 10 are patentable in view of *Bialick* and *Burger*.

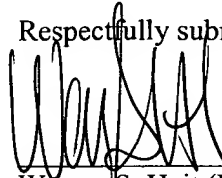
**B. Conclusion**

In view of the foregoing, Applicants respectfully submit that claims 1-21 as amended are patentable over the cited art of record. As such, early notification of allowance of claims 1-21 is earnestly requested.

The Commissioner is hereby authorized to charge the fees required for the terminal disclaimer and the extension of time under 37 CFR §§ 1.20(d) and 1.136(a), respectively, to White & Case LLP Deposit Account No. 23-1703. Applicants are unaware of any other fees due at this time. However, if other fees are due for any matter concerning this response, the Commissioner is authorized to charge the fees to the above-listed Deposit Account.

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Respectfully submitted,



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